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EXAMINER: Patel, Mital B

FOR: COLLECTION CONTAINER ASSEMBLY

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

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APPEAL BRIEF

Appellants appeal the final rejection of claims 1 and 5-9 presented in the Office Action dated January 14, 2002. A Notice of Appeal is filed herewith.

37 CFR §1.192(c)(1) -- REAL PARTY IN INTEREST

The real party in interest to this Appeal is Becton, Dickinson and Company, the owner and assignee of the captioned application.

37 CFR §1.192(c)(2) -- RELATED APPEALS AND INTERFERENCES

The Appellants, the Appellants' legal representative, and the assignee are not aware of other related appeals or interferences that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending Appeal.

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37 CFR §1.192(c)(3) -- STATUS OF THE CLAIMS

Claims 1 and 5-9 are pending in the present application, and are presented in the Appendix.

37 CFR §1.192(c)(4) -- STATUS OF AMENDMENTS

There are no outstanding amendments.

37 CFR §1.192(c)(5) -- SUMMARY OF INVENTION

The claimed invention (see also Fig.3) is a one-piece collection container assembly, containing a tubular housing having opposed first and second ends, and a solid partition within the housing between the ends. The solid partition creates a relatively low-volume collection area within the larger tubular housing, such low-volume being desired for some testing applications. The second end has a false bottom having a rounded, open bottom extending from an arcuate shoulder.

Due to its rounded open bottom, the one-piece container is universally compatible with clinical diagnostic equipment that is designed for larger, higher volume collection tubes – no adaptors or attachments are required to achieve such compatibility.

37 CFR §1.192(c)(6) – ISSUES

A. Are present claims 1 and 5-9 patentable over U.S. Patent No. 5,458,854 to Burns (“Burns”)?

37 CFR §1.192(c)(7) -- GROUPING OF CLAIMS

Claims 1 and 5-9 stand or fall together.

37 CFR §1.192(c)(8) -- ARGUMENTS

Burns does not render the invention of claim 1, or its dependent claims, obvious under 35 U.S.C. § 103(a), for the following reasons.

Appellant’s claim 1 recites, among other things, the following features (numbers refer to Fig. 3):

- a one-piece collection container assembly (50) comprising an elongated tubular housing;
- the second end of the housing comprising a false bottom end (82) comprising a rounded open bottom end (80) extending from an arcuate shoulder (86).

Significant features are thus a one-piece assembly, and a rounded bottom extending from an arcuate shoulder.

Burns discloses a reduced-volume collection container having a closed bottom end (38) and an annular skirt (37) extending from the closed bottom end to both define a compartment area (39) and to allow the container to be placed upright on a flat surface. (See Col. 3, lines 43-53). As clearly seen from Burns Figs. 1 and 2, and as admitted by the Examiner in Paragraph 8 of the final Office Action of January 14, 2002, Burns does not disclose a false bottom end having a rounded open bottom end extending from an arcuate shoulder.

The Examiner's position is that the modifications necessary to transform the Burns assembly into the claimed assembly would have been obvious, in order to make the Burns collection assembly more compatible with standard equipment. The Examiner has not pointed to a specific reference or specific combination of references that allegedly provide such motivation to (50) modify Burns, but simply relies on examples of specimen collection containers having a rounded bottom.

The Examiner's position is not sufficient to show that the appealed claims are obvious.

If a user of the Burns collection container desired compatibility with diagnostic equipment, Burns provides its own solution – one or more extensions (90) placed into the annular skirt (37). (See Figs. 7 and 8, and Col. 5, lines 13-24.) Thus, the only motivation the Examiner has presented for changing the Burns design, i.e., compatibility, is already addressed within Burns itself. Thus, one skilled in the art, reading Burns, would have no apparent need to modify the Burns container for diagnostic compatibility.

In addition, Burns discloses that its annular skirt has 2 specific functions – allowing the assembly to be placed upright on a flat surface (Col. 3, lines 50-52), and being compatible with the container cap, such that the cap can be retained at the bottom of the Burns assembly during

sample collection (Col. 5, lines 7-12). Modifying the Burns container in the manner necessary to reach Appellant's claimed invention goes against these explicit functions of the Burns container. One would not do so, particularly where Burns provides its own solution to the issue of compatibility with equipment.

Moreover, such a modification of the Burns container would in fact destroy these 2 functionalities, since a rounded bottom would not allow one to place the container on a flat surface, nor would the rounded bottom retain the cap during use. It is well-accepted that an obviousness rejection based on modifying or combining references in a manner that destroys the references' intended function cannot stand. See, e.g., In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

Thus, (a) one skilled in the art, reading Burns (either with or without references to containers with rounded bottoms) would not have had the requisite motivation to replace the annular skirt in favor of a rounded bottom extending from an arcuate shoulder, and/or to replace the tube/extension assembly of Burns with a unitary assembly, and (b) modifying Burns in the manner urged by the Examiner would destroy the stated functions of the Burns container.

CONCLUSION

For the reasons above, Appellants respectfully request of all rejections and allowance of claims 1 and 5-9.

If there are any additional fees related to this Appeal Brief, such fees should be charged to Deposit Account No. 02-1666.

Respectfully submitted,



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APPENDIX

1. A one piece collection container assembly comprising:
an elongate tubular housing having opposed first and second ends and a cylindrical wall therebetween defining a tubular interior; and
a solid partition positioned within said housing between said first and second ends;
said housing defining a volume for specimen collection therein between said first end and said partition;
said second end comprising a false bottom end comprising a rounded open bottom end extending from an arcuate shoulder.
5. The assembly of Claim 1, wherein said partition is arcuate in shape to provide said volume for specimen collection with at least a partially rounded bottom portion.
6. The assembly of Claim 1, wherein said partition is conical in shape.
7. The assembly of Claim 1, wherein said housing is a thermoplastic polymer.
8. The assembly of Claim 7, wherein said thermoplastic polymer is polyethylene terephthalate, polypropylene, polyethylene napthalate, polyvinyl chloride or copolymers thereof.
9. The assembly of Claim 1, wherein said housing comprises an outer diameter, a length and an internal volume, wherein said outer diameter is about 13 to about 16 millimeters, said length is about 75 to about 100 millimeters and said internal volume is about 1 to about 3 milliliters.